

II. REMARKS

The following remarks address this amendment.

III. PROCEDURAL HISTORY

On February 27, 2009, the BPAI improperly decided an appeal, -- on claims no longer pending. The applicant has complained, and requested that their congressional representatives investigate and request corrective action.

The BPAI decision overlooked the examiner's intervening office action and the applicant's amendment in response to that office action on February 6, 2009.

Upon notification by the applicant, the BPAI reissued its decision with a footnote indicating that the intervening office action and the amendment were not entered, as an excuse to not have to withdraw the BPAI decision as procedurally improper.

Notwithstanding the foregoing errors, the BPAI maintained its position in response to petition, which leaves the application in limbo, returned to the examiner with an unentered amendment in response to a vacated office action expressing the examiner's concerns under 35 USC 101. Thus, the claims decided on appeal are not the ones the examiner nor the applicant intend to be present.

Dr. Ziska, representing the applicant, spoke via telephone with Examiner Borissov on March 12, 2009 during which Examiner Borissov indicated he would not consider the February 6, 2009 amendment given the BPAI actions. That is understandable, and appropriate, given the BPAI decision and instructions.

However, the BPAI decision includes a new ground of rejection by the BPAI under 37 CFR 41.50(b). Pursuant to 37 CFR 41.50(b)(1), therefore, the applicant has the absolute right to reopen prosecution by submitting an appropriate amendment. This is such an appropriate amendment.

IV. SUMMARY OF BPAI DECISION

The BPAI decision:

1. Affirmed the rejections as to claims 1, 2-12, and 14-32;
2. Entered a new ground of rejection under 37 CFR § 41.50(b) of claim 1 under 35 USC 101; and
3. Reversed the rejections of claims 33 and 34.

Regarding claims 33 and 34, the BPAI decision stated that:

However, with respect to the subject matter of claim 33, we agree with the Appellant that neither Plantz or Hager disclose the specific details of how each party is defined by specific rights nor has the Examiner provided reasoning or other findings why a person with ordinary skill in the art would have divided the access rights in the manner as claimed.

Accordingly we do not sustain the rejection of claim 33 and because claim 34 depends from claim 33, and since we cannot sustain the rejection of claim 33, the rejection of claim 34 likewise cannot be sustained.

Claims 33 and 34 to which the BPAI decision referred, are believed to read as follows, with reference to the claims from which they depended:

Claim 31: A computer implemented manuscript review and determination process, comprising:

receiving at a central computer manuscript data from a remote terminal associated with an author, said manuscript data defining a complete manuscript including at least one of text data, audio data, and video data;

generating at said central computer a request to review prompt for prompting a potential reviewer for agreement to review said manuscript;

transmitting said request to review prompt to a remote terminal associated with said potential reviewer;

storing in a database controlled by said central computer agreement data received from said potential reviewer at said central computer, said agreement data including at least one of agreement to review and disagreement to review said manuscript; and

storing a decision whether to publish said manuscript.

Claim 32: The method of 31 further comprising storing at said central computer different rights relating to a manuscript for users defined as author, editor, associate editor, and reviewer.

Claim 33: The method of claim 32 further comprising configuring said central computer wherein a user defined as an author of said manuscript has rights to get status information relating to said manuscript, a user defined as an editor has rights to assign associate editors to said manuscript, assign reviewers to said manuscript, view, authorize publication, and get status information for said manuscript, a user defined as an associate editor for said manuscript has rights to assign reviewers to said manuscript, view, authorize publication, and get status information for said manuscript and does not have rights to assign additional associate editors to said manuscript, a user defined as a reviewer of a manuscript has rights to indicate whether said manuscript should be published, and get status information on said manuscript.

Claim 34: The method of claim 31 further comprising storing at said central computer different rights relating to a manuscript for users defined as author editor, associate editor, reviewer, and staff member.

In response, to the reversal of rejections of claims 33 and 34, the applicant places claims 33 and 34 in independent form by incorporating into them the limitations from their base claims.

The BPAI decision rejects claim 1 under 35 USC 101. In response, the applicant amends claim 1 to overcome the rejection under 101 by tying steps to computer structure, and replaces the claims previously depending from claim 1 with new claims 36-57. New claims 36-45 depend from claim 1. New claims 46-57 define a system and computer program product analogous to amended claim 1.

In addition, claim 1 now incorporates the "specific details of how each party is defined by specific rights" which formed the basis for the BPAI conclusion and

holding that claims 33 and 34 were non obvious over the prior art. Accordingly, claim 1 is non obvious for over the prior art for at least the same reasons as claims 33 and 34. In this regard, please note that res judicata as to obviousness is believed to apply, even though claim 1 is not one of the claims for which the rejections were in fact reversed, because of the limitations added to claim 1 regarding "how each party is defined by specific rights."

The undersigned called and left Examiner Borissov a voicemail on 5/8/2009 requesting discussion to resolve quickly any remaining issues. Since Examiner Borissov was unavailable, the undersigned respectfully requests that he call back if upon review he finds any issues that still need to be addressed in view of this amendment. The undersigned's direct dial is 703-415-0012 ext. 21.

5-8-2009

Respectfully Submitted,
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Attorney of Record

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Date/time code: May 8, 2009 (5:21pm)

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